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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,206	03/22/2004	Masahiko Kubo	1254-0246PUS1	9119
2292	7590	09/18/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			RODEE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/805,206

Applicant(s)

KUBO, MASAHIKO

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 7 is/are allowed.
6) ☒ Claim(s) 1, 2 and 4-6 is/are rejected.
7) ☒ Claim(s) 3 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

The material added to the specification at page 11, lines 1 and 2, is objected to as being an improper incorporation. The amendment includes a statement that there is no new matter but does not include a statement that the material being inserted is the material previously incorporated by reference. See the last Office action, p. 2, and 37 CFR 1.57(f). Applicants are also required to provide a copy of the JIS K 2235-5.4 for the file and, if available, an English translation. See 37 CFR 1.57(e). This copy must be accompanied by a statement that the copy supplied consists of the same material incorporated by reference in the referencing application.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000-267338 in view of *Handbook of Imaging Materials* to Diamond, pp. 162-165, 167, 168.

The claims are the same as presented for consideration at the time of the last Office action. These claims were rejected by the same combination of references as set forth above.

Applicants traverse the rejection because the JP document does not disclose the claimed combination of carnauba wax and nonpolar paraffin wax as releasing agents in a toner also containing binder resin and colorant. Applicants also rely on the evidence in the specification to show that the claimed combination of materials in the toner gives an unexpected

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result as compared to certain examples having different characteristics from those preferred for the instant toner.

Although applicants are correct that the JP document does not exemplify a toner having at least a colorant, a releasing agent and a binder resin where the releasing agent is a mixture of carnauba wax and nonpolar paraffin wax, the JP document does exemplify a toner having the requisite binder resin, coloring agent, and carnauba wax in Example 3. The reference also teaches that paraffin wax is an effective wax in the toner (§ [0029]). Each of the recited waxes is taught by the reference as useful and as alternatives for each other for the same function. As discussed in the last Office action, “the artisan would also have found it obvious to use a combination of carnauba and paraffin waxes disclosed by the reference as effective because ‘it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art.’ *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).” The use of the combined carnauba and nonpolar paraffin waxes would have been obvious given the disclosure of the Japanese document in combination with the legal reasoning given in *Kerkhoven*. It is true that the JP document does not disclose the same benefit disclosed in the specification for the combination of waxes (see response p. 7), there is no requirement in US law that the prior art disclose applicant’s concerns in order to set forth a proper case of obviousness under section 103. See *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990). The combined art sets forth a *prima facie* case of obviousness.

Applicants also rely on the evidence of record to show that the claimed toner has an unexpected benefit due to the combination of waxes in the toner having the recited binder resin containing the polyester and the colorant. The evidence of record has been considered with

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specific reference to the discussion of the toners in Table 1 (spec. p. 12) and the copying properties of these toners disclosed in Table 2 (p. 14). Initially it is noted that many of the comparative examples also have the requisite characteristics of the claimed toner. With respect to claim 1, Examples 1-12 and Comparative Examples 3-10 have the requisite components and polyester acid value. The results for these examples, as summarized in Table 2, show characteristics that appear to be both within and outside the bounds of what the inventors desire yet all these examples are within the scope of claim 1. The dependent claims also have inventive and comparative examples within the scope of the claims. Specifically, Comparative Examples 3-6, 9 and 10 are within the scope of claim 2, Comparative Examples 5-10 are within the scope of claim 4, Comparative Examples 3, 4, and 7-10 are within the scope of claim 5, and Comparative Examples 3-8 are within the scope of claim 6. It is unclear how the evidence shows an unexpected result for the instant invention when the examples included within the scope of the claims have results not desired by applicants.

It is also not clear that the inventive examples show an unexpected result over the inventive examples. As an example, the non-offset region, fixing strength, storability, and fogging results for Comparative Example 6 are the same as or nearly the same as those for the inventive examples. The Examiner acknowledges that Comparative Example 6 has a lower upper non-offset region than the inventive examples but there does not appear to be a practical advantage for a higher upper offset region because the fixing member would have to be hotter and consume more power to use this upper region. Comparative example 10 appears to have all features nearly the same as those indicated by the inventive examples as desired. It is unclear how the evidence is showing an unexpected result for the claimed invention versus the comparatives.

The rejection is still seen as persuasive and is maintained.

Allowable Subject Matter

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 7 is allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cdr
6 September 2006



CHRISTOPHER RODEE
PRIMARY EXAMINER